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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/806,909	<b>Applicant(s)</b> BESSLER ET AL.	
	<b>Examiner</b> Adrian J. McPhillip	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 20-33 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 20-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20040721, 20090204</u> .                                      | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The following is a non-final, first office action on the merits. Claims 1-9, 11 and 15 were amended by the Applicant in the communication filed on January 12, 2009. Claims 16-19 and 34 were withdrawn. Claims 1-15 and 20-33 are currently pending in this application.

### ***Election/Restrictions***

2. Claims 16-19 and 34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 12, 2009.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The aforementioned claims are directed to an apparatus, in particular a system, but recite various limitations that are directed to steps or actions. For example, “a log adapter that communicates with the log file to obtain at least a portion of the application data.” It is unclear from applicant’s claim language whether applicant intends to claim a method or an apparatus, clarification is needed.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-15 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter. Claims 1-15 are directed toward functional descriptive material, specifically: a system comprising applications, components, adapters and agents. The claims do not positively recite elements that necessarily constitute a system or apparatus, and further do not positively tie the method steps being performed to any specific structure or apparatus. Rather, the claims could be directed to software. Software per se is not patentable under § 101; therefore, the claimed invention does not fall within a statutory class of patentable subject matter.

7. Claims 20-33 are rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter based on Supreme Court precedent, and recent Federal Circuit decisions, *In re Bilski* U.S. Court of Appeals Federal Circuit 88 USPQ2d 1385. The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590.

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8. The methods recited in claims 20-33 are neither tied to a machine nor do they transform the underlying subject matter to a different state or thing. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); and *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

9. A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 20-33 fail to meet the above requirements because they are not tied to a particular machine. Since the Applicant's method steps fail the first prong of the new Federal Circuit decision, as they are not tied to another statutory class and can be preformed without the use of a particular apparatus, claims 20-33 are non-statutory.

10. When amending claims 20-33, Applicant is reminded that nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 20-21, 23, 25 and 27-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Helmus et al. (US 20030225595 A1) – hereinafter Helmus.

12. Regarding **claim 20**, Helmus discloses a method for monitoring order processing by an order processing system including applications operating on computer systems, the method comprising:

- processing at least a portion of the orders by one or more of the applications (see ¶ [0001]-[0020]) and;
- writing, by the applications, application data related to the applications processing of the orders to one or more log files (see at least ¶ [0011] wherein the system comprises a graphical user interface that produces and stores system reports and order statistics. Additionally ¶ [0124]-[0125] disclose the command and control module tracks and records information regarding any and all aspects of the system including, as shown in figure 18, information related to the applications/queues processing specific parts of the order in question;
- writing to the one or more log files hardware information related to the computer systems whereon the applications process the orders (see ¶ [0060] wherein the Command and Control Processor is in communication with each system processor and provides an interface through which real time information regarding, for example, system queues, order location, system resources, and system production is

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- displayed, managed and processed. Also see ¶ [0020] wherein the system reports generated are equivalent to applicant's log files); and
- aggregating at least portions of the hardware information and application data to monitor the order processing (see at least **claims 43-47**, ¶ [0011], [0060] & [0124]-[0125]).

Regarding **claim 21**, Helmus discloses a method for monitoring order processing by an order processing system including applications operating on computer systems, the method comprising generating application data and using the application data to determine the status of one or more orders (see at least ¶ [0011] wherein the system comprises a graphical user interface that produces and stores system reports and order statistics. Additionally ¶ [0124]-[0126] disclose the command and control module tracks and records information regarding any and all aspects of the system including, as shown in figure 18, information related to the status of the applications/queues processing certain orders).

Regarding **claim 23**, Helmus discloses a method for monitoring order processing by an order processing system including applications operating on computer systems, the method comprising generating application data and using the application data to determine the status of one or more orders, wherein the status of the orders includes identifying the particular application currently processing the order (see **fig. 18**).

Regarding **claim 25**, Helmus discloses the method of Claim 20, further comprising:

- graphically illustrating an architecture of the computer systems used by the applications to process portions of the orders (see at least **fig. 18**);

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- selecting a component of the illustrated architecture of the computer system (see ¶ [0124] wherein the Command and Control module tracks work queue activity, individual user activity, process control information, system production and system resource availability. The Command and Control module allows the user to extract information on any single queue or groups of queues, which represent various applications processing orders – see fig 18, and perform manipulations on the extracted data through standard database query tools to produce status reports on any single, or in combination, aspect of the system; and
- displaying hardware statistics of the selected component of the computer system (see ¶ [0124] wherein the command and control module allows users to extract information on any single queue or groups of queues, which represent various applications processing orders. This information includes hardware statistics like system production and system resource availability.).

Regarding **claim 27**, Helmus discloses the method of Claim 20 further comprising providing a graphical user interface identifying each of the applications processing the orders, the graphical user interface further identifying the total orders received by each of the applications (see at least ¶ [0125]-[0128] and **fig. 18**).

Regarding **claim 28**, Helmus discloses the method of Claim 20, further comprising:

- providing a first graphical user interface operable for monitoring orders (see **fig 18-22**;
- providing a second graphical user interface operable for monitoring the computer systems (see ¶ [0124] wherein the command and control module allows users to



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extract information on any single queue or groups of queues, which represent various applications processing orders. This information includes hardware statistics like system production and system resource availability.); and

- providing a third graphical user interface for detailing order processing totals and application processing totals (see at least ¶ [0128] and **fig. 20**).

Regarding **claim 29**, Helmus discloses the method of Claim 28, further comprising:

- selecting the first graphical user interface and identifying one or more of the orders to monitor (see ¶ [0123]-[0128]);
- searching the application data for the orders identified (see ¶ [0125]-[0126]); and
- providing, via the first graphical user interface, an order report identifying the current status of an order (see ¶ [0123]-[0128] wherein the user interface allows users to drill down the entries using hyperlinks to their supporting data.

Furthermore ¶ [0124] explicitly discloses that the interface produces status reports for the orders being processed.).

Regarding **claim 30**, Helmus discloses the method of Claim 29, further comprising:

- establishing an alarm threshold for an application related to processing of the orders (see ¶ [0130]);
- notifying, via the first graphical user interface, when the alarm threshold has been exceeded (see ¶ [0130]).

Regarding **claim 31**, the claims recites equivalent limitations to claim 30 except that it is directed to one or more orders. The system disclosed by Helmus processes one or more orders

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therefore this limitation is insufficient to distinguish claim 31 over the prior art applied to claim 30.

Regarding **claim 32**, Helmus discloses the method of claim 28 further comprising:

- providing an architectural components illustration of the computer system via the second graphical user interface (see **fig. 18**);
- selecting one of the architectural components illustrated by the second graphical user interface; and providing, via the second graphical user interface, component details of the selected architectural component (see ¶ [0124] wherein the command and control module allows users to extract information on any single queue or groups of queues, which represent the various applications, or computer architecture components, processing orders. The extracted information includes component details like system production and system resource availability.)

Regarding **claim 33**, Helmus discloses the method of Claim 31, further comprising notifying, via pager, when the alarm threshold has been exceeded (see ¶ [0130]).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davies et al. (US 2003/0033191 A1) – hereinafter Davies, in view of Waclawsky et al. (US 6850530 B1) - hereinafter Waclawsky.

16. Regarding **claim 1**, Davies discloses a system for monitoring events processed by event processing applications implemented on computer systems, the event processing monitor comprising:

- an application that processes a portion of an event and writes application data to a log file, the application data related to the processing of the event by the application (see at least **Abstract** wherein the system comprises a software engine that processes and monitors various events in a business lifecycle and ¶ [0020] wherein the phases of the lifecycles being monitored comprise state information that is stored and updated;
- a log adapter that communicates with the log file to obtain at least a portion of the application data (see ¶ [0038] wherein the software engine communicates with the stored data, specifically that data related to the status of the business process being monitored, and returns an indicator of the event's status);

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- a monitor component in communication with the log adapter that obtains the portion of the application data, the monitor component determines event status information using the obtained application data (see ¶ [0038]).

Davies does not explicitly teach: a log agent that monitors a resource data related to a computer system used by the application to process at least some of the event; or having the disclosed monitoring component obtain at least a portion of resource data, in addition to the obtained application data, and determine event status information using both the disclosed application data and the obtained resource data.

Waclawsky, however, discloses a system for monitoring resource data related to a computer system within a network in order to maximize efficiency (see at least ¶ cols. 3-6).

In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case the combination of the event monitoring application disclosed by Davies and the computer resource monitoring system disclosed by Waclawsky would yield a predictable result, specifically an event monitoring system that tracked the computer resources being allocated to the software applications disclosed by Davies that are monitoring the various phases of a business lifecycle. It would have been obvious to one of ordinary skill in the art to modify the monitoring component of the system of Davies to include accessing and storing resource data related to a computer system used by the application to process at least some of the event being

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monitored, because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

Additionally, it would have been obvious to further modify the monitoring component disclosed by Davies to obtain at least a portion of resource data, as disclosed by Waclawsky, and then determine event status information using both the disclosed application data and the obtained resource data. Davies already discloses using application data to determine event status information, therefore using both application and resource data to determine this information would require only a combination of the criteria already disclosed by Davies with the resource data presented by Waclawsky. Again, because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, the combination is deemed obvious.

Regarding **claim 2**, Davies discloses a system for monitoring events processed by event processing applications implemented on computer systems comprising an application that processes a portion of an event and writes application data to a log file, but fails to explicitly teach wherein a log agent writes resource data to the log file.

As stated previously, Waclawsky discloses a system for monitoring resource data related to a computer system within a network in order to maximize efficiency, and it would have been obvious to combine the two references so that the system of Davies also monitors and tracks computer resource data. Furthermore, it would have been obvious to have the application disclosed by Davies write resource data, in addition to the already disclosed application data, to

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the log file in question because so doing would merely require the combination of old and well known elements.

In this case the combination of the application data disclosed by Davies and the computer resource monitoring data disclosed by Waclawsky would yield a predictable result, specifically an event monitoring system that tracked the computer resources being allocated to the software applications disclosed by Davies, and recorded that data in the log file with the already stored application data. Therefore the combination would have been obvious to one of ordinary skill in the art because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Regarding **claim 3**, Davies discloses a system for monitoring events processed by event processing applications implemented on computer systems comprising an application that processes a portion of an event and writes application data to a log file, but fails to explicitly teach wherein a log agent writes resource data to the log file and the log file is defined as a database having a first file that receives the application data and a second file that receives the resource data.

As stated previously, Waclawsky discloses a system for monitoring resource data related to a computer system within a network in order to maximize efficiency, and it would have been obvious to combine the two references so that the system of Davies monitors and tracks computer resource data and combines this resource data with the application data in the log file. Additionally though, it would have been obvious to explicitly have the log file comprise a first file for receiving the application data and a second file for receiving the resource data. It is the

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Examiner's position that absent evidence of new or unexpected results, it is not inventive in terms of patentability to take one or more files ( $A_1, A_2, A_3, \dots A_N$ ), that receive and store multiple elements, and break these files down into separate files containing the same information.

A modification for creating separate files (for example splitting a log file that receives and stores both resource and application data, disclosed by the combination of Davies and Waclawsky, into separate files) is analogous to making functions, structures, or actions separable. When the difference between the claimed invention and the prior art is that the prior art does not disclose an element as separable, as a matter of law, it would have been obvious to one having ordinary skill in the art to make the element separable to achieve a predictable result. *See* MPEP § 2144.04 V.C. and *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). Therefore this limitation fails to distinguish the claimed invention over the applied prior art.

Regarding **claim 4**, Davies discloses a system for monitoring events processed by event processing applications implemented on computer systems, wherein the monitor component aggregates the application data to determine a current status of the event (see at least ¶ [0032]-[0038] wherein the software engine communicates with the stored data, specifically that data related to the status of the business process being monitored, and returns an indicator of the event's status and application. This data, including event status information, is aggregated and continuously updated as objects or events are added, moved, and/or modified.).

Regarding **claims 5-7**, the claims recite equivalent limitations to claims 1-4 except that the claims are directed to a system comprising a plurality of the claimed components. It is first

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noted that the system disclosed by the combination of Davies and Waclawsky is taught as being implemented in a networked environment where there are multiple computers operating the disclosed software application (see at least Davies ¶ [0105] and **fig. 50**). Therefore it would be obvious to one of ordinary skill in the art for each of the computers in the network to have the disclosed components and structure necessary to implement the disclosed invention.

Furthermore, the courts have held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced, *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Merely duplicating the system recited in claims 1-4 such that there are now a plurality of the necessary components would not produce a new and unexpected result. Therefore this limitation is insufficient to distinguish claims 5-7 over the prior art applied to claims 1-4.

Regarding **claim 8**, Davies discloses a system for monitoring events processed by event processing applications implemented on computer systems, wherein the monitor component aggregates the application data to determine a current status of the event (see at least ¶ [0032]-[0038] wherein the software engine communicates with the stored data, specifically that data related to the status of the business process being monitored, and returns an indicator of the event's status and application. This data, including event status information, is aggregated and continuously updated as objects or events are added, moved, and/or modified.). Davies does not explicitly teach wherein the monitor component aggregates resource data and provides a computer architecture information.

Waclawsky however, discloses aggregating resource usage information in a database allowing the user to isolate and improve bottlenecks in a computer architecture (see at least **col. 12, lines 35-60**).



In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case the combination of the event monitoring application disclosed by Davies and the computer resource monitoring system disclosed by Waclawsky would yield a predictable result, specifically an event monitoring system that tracked the computer resources being allocated to the software applications disclosed by Davies that are monitoring the various phases of a business lifecycle. It would have been obvious to one of ordinary skill in the art to modify the monitoring component of the system of Davies to include aggregating resource data and providing a computer architecture information, because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

Regarding **claim 9**, the claim recites equivalent limitations to claim 8 except that monitor component provides capacity information. Davies does not explicitly teach wherein the monitor component aggregates resource data and provides a computer capacity information.

Waclawsky however, discloses aggregating resource usage information in a database allowing the user to isolate and improve bottlenecks in a computer architecture. Waclawsky goes

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on to say that the invention uses this data to assist with capacity planning, thereby implying that an embodiment of the invention provides capacity information (see at least **col. 12, lines 35-60**).

In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case the combination of the event monitoring application disclosed by Davies and the computer resource monitoring system disclosed by Waclawsky would yield a predictable result, specifically an event monitoring system that tracked the computer resources being allocated to the software applications disclosed by Davies that are monitoring the various phases of a business lifecycle. It would have been obvious to one of ordinary skill in the art to modify the monitoring component of the system of Davies to include aggregating resource data and providing a computer capacity information, because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

Regarding **claim 10**, Davies discloses the system of claim 1 wherein the computer system includes one or more computers and wherein the application is operable on the one or more computers (see at least ¶ [0105] and **fig. 50** wherein it is disclosed that the system is implemented in a networked environment where there are multiple computers operating the

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disclosed software application). Furthermore, the courts have held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced, *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Merely duplicating the system recited in claims 1 such that there are now one or more computers would not produce a new and unexpected result. Therefore this limitation is insufficient to distinguish claim 10 over the prior art applied to claims 1.

Regarding **claim 11**, Davies discloses a system for monitoring events processed by event processing applications implemented on computer systems, wherein the monitor component aggregates the application data to determine event status information during processing of the event by the application (see at least ¶ [0032]-[0038] wherein the software engine communicates with the stored data, specifically that data related to the status of the business process being monitored, and returns an indicator of the event's status and application. This data, including event status information, is aggregated and continuously updated as objects or events are added, moved, and/or modified.)

Davies does not explicitly teach wherein the monitor component aggregates resource data and determines event status information using both the disclosed application data and the obtained resource data.

Waclawsky however, discloses aggregating resource usage information in a database allowing the user to isolate and improve bottlenecks in a computer architecture. Waclawsky goes on to say that the invention uses this data to assist with capacity planning, thereby implying that an embodiment of the invention provides capacity information (see at least **col. 12, lines 35-60**).

In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case the combination of the event monitoring application disclosed by Davies and the computer resource monitoring system disclosed by Waclawsky would yield a predictable result, specifically an event monitoring system that tracked the computer resources being allocated to the software applications disclosed by Davies that are monitoring the various phases of a business lifecycle. It would have been obvious to one of ordinary skill in the art to modify the monitoring component of the system of Davies to include aggregating resource data and providing a computer capacity information, because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

Additionally, it would have been obvious to further modify the monitoring component disclosed by Davies to obtain at least a portion of resource data, as disclosed by Waclawsky, and then determine event status information using both the disclosed application data and the obtained resource data. Davies already discloses using application data to determine event status information, therefore using both application and resource data to determine this information would require only a combination of the criteria already disclosed by Davies with the resource

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data presented by Waclawsky. Again, because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, the combination is deemed obvious.

Regarding **claim 12**, Davies discloses a system for monitoring events processed by event processing applications implemented on computer systems comprising an application that processes a portion of an event and writes application data to a log file, but fails to explicitly teach wherein the application data includes a name associated with the application processing the order and one or more time stamps associated with when the application processes portions of the event.

Examiner first notes that this limitation is directed to the actual content of the application data and therefore comprises non-functional descriptive material. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr,

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450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the actual content of the application data adds little, if anything, to the claimed acts or steps and thus does not serve as a limitation on the claim to distinguish it over the prior art. MPEP 2106 IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. The content of the application data, including whether or not it contains an application name or time stamp, does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Secondly, the Examiner hereby takes official notice that it was well known to those of ordinary skill in the art of computer software development, at the time of the invention to record application names and time stamps for applications that are processing data on a computer. It

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would have been obvious to modify the system disclosed by Davies to include this feature so that there is greater transparency throughout the business project and users can determine which computer's are processing what data and how long they have been doing so. This allows users to more easily identify bottlenecks in the project and the specific computer applications, or processes, responsible for them.

Regarding **claims 13 & 14**, the Examiner has already asserted that the combination of Davies and Waclawsky teaches the monitor component aggregating application and resource data and determining event status information using both the disclosed application data and the obtained resource data. Waclawsky further teaches wherein the resource data includes hardware statistics related to the computer system and the hardware statistics are a memory parameter of the computer system (see at least **col. 3, lines 26-58** wherein the resource data being analyzed includes hardware resources such as memory locations). Examiner's motivation for combining these two references has been previously presented.

Regarding **claim 15**, the Examiner has already asserted that the combination of Davies and Waclawsky teaches the monitor component aggregating application and resource data and determining event status information using both the disclosed application data and the obtained resource data. Waclawsky further discloses a monitor component using resource data including memory data and resource allocation (see at least **col. 3, lines 26-58**) to determine resource/memory usage (see **col. 12, lines 35-60**). Examiner's motivation for combining these two references has been previously presented, however neither reference explicitly discloses allocating all memory on startup to cache memory.

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The Examiner hereby takes official notice that it was well known to those of ordinary skill in the art, at the time of the invention, for computers to allocate all memory on startup to cache memory. This is a common startup technique for most personal computers, which Applicant even admits on page 12 of submitted disclosure.

Following KSR, the Supreme Court issued several rationales for supporting a conclusion that a claim would have been obvious. If a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art, and one of ordinary skill in the art would have been capable of applying this known technique to a known device (method, or product) and the results would have been predictable to one of ordinary skill in the art; then the claim will be deemed obvious in view of the prior art.

Applicant is applying a known technique, in this case allocating all memory on startup to cache memory, to a known device, in this case to the computer monitoring system disclosed by Davies, and is generating a predictable result. It would have been obvious, to one of ordinary skill in the art, that the result of applying the aforementioned technique would be a computer monitoring system that allocated all memory to cache memory on startup. Therefore since the Applicant is claiming the application of a known technique to a known device to yield a predictable result, the claim is deemed obvious in view of the prior art.

17. Claims 22, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helmus (US 20030225595 A1).

18. Regarding **claim 22**, the Examiner has previously asserted that Helmus discloses a method for monitoring order processing by an order processing system including applications



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operating on computer systems, the method comprising generating application data and using the application data to determine the status of one or more orders. Helmus does not however, explicitly teach wherein the status of the orders includes a percentage complete of processing of the one or more orders.

The Examiner hereby takes official notice that it was well known to those of ordinary skill in the art, at the time of the invention, for status reports to include a percentage complete statistic of the variable being monitored, for example when downloading documents.

In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case the combination of the order status reports disclosed by Helmus and a percentage complete statistic would yield a predictable result, specifically an order status report that included a statistic indicating the percentage of order processing that has been completed. It would have been obvious to one of ordinary skill in the art to modify the status reports of Helmus to include the percentage of order processing that has been completed because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

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Regarding **claim 24**, Helmus discloses a method for monitoring order processing by an order processing system including applications operating on computer systems, the method comprising generating application data and using the application data to determine the status of one or more orders in order to reduce order processing time (see ¶ [0016]). Helmus does not explicitly teach that the status of the orders includes the processing time of the one or more orders by the particular application.

The Examiner hereby takes official notice that it was well known to those of ordinary skill in the art, at the time of the invention, for status reports to include a processing time statistic for the variable being monitored. For example in quality control environments it was well known to determine the processing time required to complete the various tasks that comprise a particular order so that industrial engineers can then determine if and where the process can be further optimized.

In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case the combination of the order status reports disclosed by Helmus and a processing time statistic would yield a predictable result, specifically an order status report that included a statistic indicating the processing time required for the order in question. It would have been obvious to one of ordinary skill in the art to modify the status reports of Helmus to include the processing time of the one or more orders by the particular application, because the claimed

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invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

Regarding **claim 26**, the method of Claim 20 further comprising providing a graphical user interface identifying each of the applications processing the orders (see **fig 18**). Helmus does not explicitly teach the graphical user interface further identifying the processing time spent by each application on the processing of the orders

The Examiner hereby takes official notice that it was well known to those of ordinary skill in the art, at the time of the invention, for status reports to include a processing time statistic for the variable being monitored. For example in quality control environments it was well known to determine the processing time required to complete the various tasks that comprise a particular order so that industrial engineers can then determine if and where the process can be further optimized.

In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case the combination of the graphical user interface disclosed by Helmus and a processing time statistic would yield a predictable result, specifically a graphical user interface identifying each of the applications processing the orders that included a statistic indicating the processing

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time required for the order in question. It would have been obvious to one of ordinary skill in the art to modify the GUI of Helmus to include the processing time of the one or more orders by the particular application, because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

### ***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrian J. McPhillip whose telephone number is (571)270-5399. The examiner can normally be reached on Monday to Thursday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571)272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/A. J. M./

Examiner, Art Unit 3623

4/25/2009

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623